

J. MICHAEL KALER, SBN 158296  
KALER LAW OFFICES  
9930 Mesa Rim Road, Suite 200  
San Diego, California 92121  
Telephone (858) 362-3151  
Email: [michael@kalerlaw.com](mailto:michael@kalerlaw.com)

MELODY A. KRAMER, SBN 169984  
KRAMER LAW OFFICE  
9930 Mesa Rim Road, Suite 1600  
San Diego, California 92121  
Telephone (858) 362-3150

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

JENS ERIK SORENSEN, as Trustee of  
SORENSEN RESEARCH AND  
DEVELOPMENT TRUST,

Plaintiff

V.

LEXAR MEDIA, INC., *et al.*

## Defendants

JENS ERIK SORENSEN, as Trustee of  
SORENSEN RESEARCH AND  
DEVELOPMENT TRUST,

Plaintiff

V.

## PHILLIPS PLASTICS CORP., *et al*

## Defendants

- ) Case No. C08-00095 JW
- ) Case No. CV 08-3094 MHP
- )  
**) NOTICE OF MOTION AND**  
**) ADMINISTRATIVE MOTION TO**  
**) CONSIDER WHETHER CASES**  
**) SHOULD BE RELATED (L.R. 3-12**  
**) (b)); MEMORANDUM OF POINTS**  
**) AND AUTHORITIES**  
)  
**) (Filed concurrently with Proposed Order**  
**) and Declaration of inability to stipulate)**  
)  
**) Courtroom 8, 4<sup>th</sup> Floor**  
**) Judge: The Hon. James Ware**  
)  
**) *No Oral Argument Unless Requested by***  
)

) ) ) {

1 Please take notice that Plaintiff Jens Erik Sorensen, as Trustee of the Sorensen  
 2 Research and Development Trust, will move and hereby does administratively move  
 3 pursuant to Civil L.R. §§ 7-11 and 3-12(b) for the Court to consider whether  
 4 *Sorensen v. Phillips Plastics*, Case No. CV08-3094 MHP (“*Phillips*”), should be  
 5 related to the lower numbered case of *Sorensen v. Lexar Media*, Case No. CV08-  
 6 0095 JW (“*Lexar*”). This motion is supported by this Notice Of Motion And  
 7 Administrative Motion To Consider Whether Cases Should Be Related (L.R. Rule  
 8 3-12 (B)); Memorandum Of Points And Authorities; and by the Declaration of J.  
 9 Michael Kaler, filed concurrently herewith.

10

11 **SUMMARY**

12 The newly filed case, *Sorensen v. Phillips Plastics*, Case no. CV08-3094 MHP  
 13 (“*Phillips*”), in addition to having the same plaintiff as the low numbered case,  
 14 *Sorensen v. Lexar Media*, Case no. CV08-0095 JW (“*Lexar*”), also is an action to  
 15 recover for infringement of the same property, U.S. Patent No. 4,935,184 (“the ‘184  
 16 patent”). Because the two disputes relate to the same intellectual property, and both  
 17 cases will turn on the issue of claim construction of the ‘184 patent, substantial  
 18 judicial resources can be conserved by having the two cases heard by the same  
 19 Court, and consolidating certain specific procedures such as claim construction and  
 20 validity. For these reasons, the cases should be determined to be related cases and  
 21 assigned to the judge in the low numbered *Lexar* case for all further proceedings.

22 **I. THE TWO CASES ARE RELATED WITHIN THE MEANING OF**  
 23 **LOCAL RULE § 3-12.**

24 Northern District Local Rule § 3-12(a) provides that an action is related to  
 25 another when:

26 (1) The actions concern substantially the **same parties, property,**  
 27 **transaction or event; and**

1  
2 (2) It appears likely that there will be an **undue burdensome**  
3 **duplication of labor and expense or conflicting results** if the  
cases are conducted before different judges.

4 The two cases at issue share a common plaintiff, and share a dispute over the  
5 same property, a single United States patent. This confluence of partial commonality  
6 of parties and complete commonality of the subject property in the two cases  
7 satisfies the requirements of L.R. § 3-12(a)(1).

8 If the two cases are considered separately by different judges, rulings on  
9 several key issues will substantially impact rights in the other case. In particular,  
10 rulings on the key issues of the claim construction and validity of the subject patent  
11 will strongly impact ongoing proceedings in the parallel case.

12 Further, claim construction is an involved and often complex procedure in  
13 patent litigation, which requires the Court to become educated about the subject  
14 technology and the details of the file history of the subject patent. To have the cases  
15 heard by two separate judges not only requires the Plaintiff to duplicate effort in  
16 briefing and arguing the claim construction issues twice, but requires two different  
17 judges to expend the considerable judicial resources to make the determination on  
18 claim construction. Moreover, if there are even slight differences in the claim  
19 construction rulings issued by two different judges, such minor differences can cause  
20 wholly different results in the two cases. The conservation of party and judicial  
21 resources, and avoidance of inconsistent rulings, that will come from relating the two  
22 cases in front of a single judge is the purpose of Local Rule § 3-12(a)(2).

23 Similarly, the issue of validity is critical to most patent infringement lawsuits.  
24 Much like claim construction, validity is an issue, which requires the court to study  
25 the matter and the relevant prior art in great detail, typically after extensive briefing  
26 by the parties. Much like claim construction, a different finding by two different  
27 courts will likely result in wholly inconsistent determinations on the merits. Thus,  
28 like claim construction, the validity issue should be determined by a single court to

1 conserve resources and to avoid conflicting results, again independently satisfies the  
 2 requirements of Local Rule § 3-12(a)(2).

3

4 **II. THESE TWO CASES ARE THE ONLY ACTIVE '184 PATENT  
 CASES PENDING IN THIS DISTRICT.**

5

6 *Lexar* and *Phillips* are the only actively litigated cases involving Plaintiff  
 7 Sorensen and the '184 patent pending in the Northern District.

8 There are three other cases involving the '184 patent that are on file in the  
 9 Northern District. Previously, Judge Claudia Wilken referred those cases for  
 10 determination if they were related. The three cases addressed were: *Sorensen v.*  
 11 *First International Digital*, Case no. CV07-5525 JSW ("FID"); *Sorensen v. Digital*  
 12 *Networks of North America*, Case no. CV07-5568 JSW ("DNNA") and *Sorensen v.*  
 13 *Ampro Tools*, Case no. CV08-0096 CW ("Ampro"). Counsel for Sorensen and  
 14 DNNA both opposed relation of those three cases because of the default status of  
 15 both FID and Ampro. DNNA's opposition included the following statement:

16

17 As reflected in the Docket Reports for Case No. CV-05525-JSW and  
 18 Case No. CV-00096-CW. Judge White has entered a default judgment  
 19 against First International, and Judge Wilken's Clerk has entered a  
 20 Notice of Default against Ampro Tools. Unlike the suit against  
 21 DNNA, the First International and Ampro Tools cases are likely to  
 22 involve the enforcement of default judgments rather than the  
 23 interpretation of Sorensen's asserted patent.

24 DNNA's Response To Judicial Referral For Purpose Of Determining Relationship  
 25 Of Cases (Dkt. #43), Case No. 07 CV5568 JSW.

26 Additionally, the *DNNA* case is stayed pending reexamination. The defaults  
 27 and stay in those cases leave the *Lexar* and *Phillips* cases as the only active cases  
 28 involving the '184 patent in this district. There was no benefit to relating two  
 defaulted cases and one stayed case, as there were no judicial efficiencies to derive.  
 By contrast, the two active cases, *Lexar* and *Phillips*, can benefit from a substantial

1 conservation of judicial resources if they are related before the Honorable Judge  
2 James Ware, the Judge in the low numbered *Lexar* case.

3

4 **CONCLUSION**

5 For the reasons cited hereinabove regarding the overlap of common parties,  
6 the commonality of intellectual property in dispute, the substantial conservation of  
7 judicial resources, and the avoidance of inconsistent decisions that arise from having  
8 a single judge conduct all claim construction and other determinations with regard to  
9 the subject '184 patent, the *Phillips* case should be deemed related to the *Lexar* case  
10 and transferred to the judge in the low-numbered case.

11  
12 DATED this Thursday, July 17, 2008.

13 JENS ERIK SORENSEN, as Trustee of  
14 SORENSEN RESEARCH AND DEVELOPMENT  
15 TRUST, Plaintiff

16 /s/ J. Michael Kaler

17 J. Michael Kaler, Esq.  
18 Melody A. Kramer, Esq.  
19 Attorney for Plaintiff

## PROOF OF SERVICE

I, J. Michael Kaler, declare: I am and was at the time of this service working within in the County of San Diego, California. I am over the age of 18 year and not a party to the within action. My business address is the Kaler Law Offices, 9930 Mesa Rim Road, Suite 200, San Diego, California, 92121.

On Thursday, July 17, 2008, I served the following documents:

NOTICE OF MOTION AND ADMINISTRATIVE MOTION TO CONSIDER WHETHER  
CASES SHOULD BE RELATED (L.R. 3-12 (b)); MEMORANDUM OF POINTS AND  
AUTHORITIES

DECLARATION OF J. MICHAEL KALER IN SUPPORT OF ADMINISTRATIVE MOTION  
TO CONSIDER WHETHER CASES SHOULD BE RELATED

[PROPOSED ORDER] GRANTING ADMINISTRATIVE MOTION TO CONSIDER WHETHER CASES SHOULD BE RELATED (L.R. 3-12 (b))

PERSON(S) SERVED	PARTY(IES) SERVED	METHOD OF SERVICE
Jared Bobrow jared.bobrow@weil.com Weil, Gotshal & Manges LLP 201 Redwood Shores Parkway Redwood Shores, CA 94065	Lexar Media, Inc.	Email--Pleadings Filed with the Court via CM/ECF
Robert L. Binder Foley & Lardner LLP 777 East Wisconsin Avenue Milwaukee, WI 53202 414/297-4900 FAX rbinder@foley.com	Phillips Plastics Corp.	Email-- to an email address represented to be the correct email address for the above noted addressee
Richard L. Schwaab Pavan K. Agarwal C. Edward Polk, Jr. Foley & Lardner LLP 3000 K Street, N.W. Suite 500 Washington, DC 20007 202/672-5399 FAX rschwaab@foley.com pagarwal@foley.com epolk@foley.com	Phillips Plastics Corp.	Email-- to an email address represented to be the correct email address for the above noted addressee
Phillips Plastics Corp. C/o CT Corporation System 8040 Excelsior Drive, Ste. 200	Phillips Plastics Corp.	U.S. Mail

Madison, WI 53717

- (Personal Service) I caused to be personally served in a sealed envelope hand-delivered to the office of counsel during regular business hours.
- (Federal Express) I deposited or caused to be deposited today with Federal Express in a sealed envelope containing a true copy of the foregoing documents with fees fully prepaid addressed to the above noted addressee for overnight delivery.
- (Facsimile) I caused a true copy of the foregoing documents to be transmitted by facsimile machine to the above noted addressees. The facsimile transmissions were reported as complete and without error.
- (Email) I emailed a true copy of the foregoing documents to an email address represented to be the correct email address for the above noted addressee.
- (Email--Pleadings Filed with the Court) Pursuant to Local Rules, I electronically filed this document via the CM/ECF system for the United States District Court for the Southern District of California.
- (U.S. Mail) I mailed a true copy of the foregoing documents to a mail address represented to be the correct mail address for the above noted addressee.

I declare that the foregoing is true and correct, and that this declaration was executed on Thursday, July 17, 2008, in San Diego, California.

/s/ J. Michael Kaler

J. Michael Kaler